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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 92056629 |
| Party | Defendant<br>Octagon Worldwide Holdings B.V. |
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| Submission | Reply in Support of Motion |
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| Signature | /Tamara F. Carmichael/ |
| Date | 10/30/2013 |
| Attachments | 92056629 REGS REPLY IN FURTHER SUPPORT OF MOT TO TAKE PETS DEP ORALLY AND IN OPPOS TO PETS MOT TO QUASH.pdf(21798 bytes ) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| OCTAGON LAW GROUP, INC.,<br><br>Petitioner,<br><br>v.<br><br>OCTAGON WORLDWIDE HOLDINGS, B.V.,<br><br>Registrant. | Cancellation No. 92056629 |
| Mark: OCTAGON<br><br>Registration No. 2,470,833<br><br>Registration Date: July 24, 2001 | |

**REGISTRANT'S REPLY IN FURTHER SUPPORT OF MOTION TO TAKE PETITIONER'S DEPOSITION ORALLY AND IN OPPOSITION TO PETITIONER'S MOTION TO QUASH**

Registrant, Octagon Worldwide Holdings, B.V. ("Registrant"), respectfully submits this reply in further support of its Motion to take the deposition of Petitioner Octagon Law Group, Inc. by oral questions (the "Motion").

In response to Registrant's Motion, Petitioner filed a document entitled Motion to Quash Registrant's 30(B)(6) Notice of Deposition Of Petitioner, in which it opposes the Motion and seeks to quash the Notice of Deposition served on Petitioner (the "Response"). In its Response, however, Petitioner fails to show that Registrant does not have good cause for taking the deposition of Petitioner (through a Rule 30(b)(6) representative) in order that Registrant may fully defend its registration and to put itself in the best position to defend these cancellation proceedings instituted by Petitioner. In the absence of a showing of hardship by Petitioner

sufficient to outweigh Registrant's need for the deposition, the oral deposition must be permitted, as noticed.

Registrant has demonstrated it would be prejudiced if unable to take Petitioner's deposition by oral questions and has made a showing of good cause in its Motion. The Response to Registrant's motion, however, is devoid of any showing that such facts do not constitute good cause for a deposition to be taken orally. Indeed, not only has Petitioner not cited a single TTAB or court case in support of its position, but it has also failed to show that the cases cited by Registrant in support of its Motion are not applicable. Instead, Petitioner simply argues that it is located in Canada, and that a deposition would be an "inconvenience" during business hours. However, location outside of the United States and the fact that the deposition would be taken during business hours are not sufficient to overcome a showing of good cause. *See, e.g., Orion Group Inc., v. The Orion Insurance Co. P.L.C.,* 12 U.S.P.Q.2D 1923 (TTAB 1989) (permitting oral deposition of foreign party to be taken in England and holding that "[i]t would be unjust… to deprive opposer of the opportunity of obtaining discovery and specifically of confronting and examining the witness by oral examination"), *citing, Society Nationale Industrielle Aerospatiale, et. al. v. U.S. District Court for the Southern District of Iowa*, 107 U.S. 522 (1987); *Feed Flavors Incorporated v. Kemin Industries, Inc.*, 1980 TTAB LEXIS 84 (Trademark Trial & App. Bd. 1980) (finding good cause for deposition to be taken orally and rejecting excuse that deponents were "busy executives whose schedules would be disrupted less by their being deposed under Rule 2.124 rather than orally" and holding that "it would be unjust for respondent to be deprived of the valuable aid of confronting the witnesses by way of oral cross-examination"); *see also Spier Wines (PTY) Ltd. v. Ofer Z. Shepher*, 2012 TTAB LEXIS 218 (Trademark Trial & App. Bd. June 12, 2012) (noting that "a deposition on written questions … deprives an adverse party of the right to confront the witness and ask follow-up questions on

cross-examination" and holding that deposition on written questions was not adequate substitute, where the party offering the foreign witness refused to consent to an oral deposition). Moreover, Registrant will take the oral deposition in Toronto, where Petitioner is located, so Petitioner would suffer no hardship in attending an oral deposition there.[1]

Petitioner also claims in its Response that it has no presence in the United States, simply because it is a Canadian company. Petitioner ignores that it has filed a number of OCTAGON formative trademark applications in the United States – specifically, at least eight applications – and that it has asserted a good faith intent to do business in the United States such that it would necessitate the cancellation of all or part of Registrant's Registration which has been registered on the Principal Register for over 12 years, and which mark has been in use in the United States for over 15 years. Petitioner brought these proceedings, not Registrant. Petitioner has raised the issues at hand, not Registrant. Petitioner's attempt to use its intended use in the United States as a sword against Registrant, yet to hide behind the fact that it resides in Canada as a shield to Registrant's ability to take a full and complete oral deposition and to confront the witness by oral examination, should be rejected. Registrant must be given a chance to vigorously defend itself and its long-standing use and Registration.

Further, Petitioner may not itself determine the scope of discovery or whether its responses are or would be sufficient. Petitioner's self-serving statement that "it is patently clear what damage Petitioner is suffering" is an attempt to end-run around the entire discovery process and usurp the Board's role as finder of fact. If that were the case, this matter could be determined on the pleadings alone, which allegedly set forth Petitioner's claim for damage.

[1] Petitioner's claim that its counsel would need to fly to Toronto is a mere red herring, as Registrant's counsel would need to do the same and does not expect the expense to be significant, especially when compared to the need for and utility of the deposition.

However, the TBMP provides for a discovery process, in order to permit the parties to develop their own claims and challenge and confront the other party's claims. Petitioner has instituted this proceeding, challenging the registration of Registrant's mark, and, pursuant to the discovery procedures of the TBMP and applicable case law, Registrant is permitted to confront and examine the basis of Petitioner's claims and defend its registration to the fullest extent possible, including by deposing Petitioner. *See, e.g., Orion Group Inc., v. The Orion Insurance Co. P.L.C.*, 12 U.S.P.Q.2D 1923 (TTAB 1989) (holding that where foreign entity sought to register and use marks in the United States, it would be "unjust" to deprive opposer the opportunity of obtaining discovery and confronting foreign witness by oral examination); *Feed Flavors Incorporated v. Kemin Industries, Inc.*, 1980 TTAB LEXIS 84 (Trademark Trial & App. Bd. 1980) (holding that "it would be unjust for respondent to be deprived of the valuable aid of confronting the witnesses by way of oral cross-examination").

In conclusion, Petitioner has not shown that it would suffer hardship through the taking of a deposition near its place of business, however the record reflects that Respondent will be prejudiced if it is unable to question and confront Petitioner's witness about the basis for its claim. There is no good cause to deny Registrant the right to be deprived of the value of confronting the witness and to take an oral deposition, subject to cross-examination. Accordingly, the balance of equities favor Registrant.

WHEREFORE, Registrant respectfully requests that the Board issue an order permitting the deposition of Petitioner to proceed by oral examination. In light of the upcoming discovery deadlines, Registrant also respectfully requests that the Board suspend proceedings pending disposition of Registrant's motion.

Respectfully submitted,

Dated: New York, New York
October 29, 2013

LOEB & LOEB LLP

By: /s/ Tamara Carmichael
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## CERTIFICATE OF SERVICE

I, Angela Ocasio Provencio, hereby certify that a copy of this **REGISTRANT'S REPLY IN FURTHER SUPPORT OF MOTION TO TAKE PETITIONER'S DEPOSITION ORALLY AND OPPOSITION TO PETITIONER'S MOTION TO QUASH** has been served upon:

MARIA V HARDISON
TASSAN & HARDISON
4143 27TH STREET N
ARLINGTON, VA 22207-5211

via first-class mail, postage pre-paid, on October 29, 2013.

/s/ Angela Ocasio Provencio

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